

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

WIRTGEN AMERICA, INC.,)	
)	
Plaintiff,)	
)	C.A. No. 17-770-JDW
v.)	
)	JURY TRIAL DEMANDED
CATERPILLAR INC.,)	
)	
Defendant.)	

ORDER REGARDING IPR ESTOPPEL

WHEREAS, on February 6, 2024, the Patent Trial and Appeal Board (“PTAB”) issued a Final Written Decision in IPR2022-01310 (“the 1310 IPR”) in which Caterpillar Inc. (“Caterpillar”) challenged claims 1, 12, 15, 16, 22, 23, and 26 of U.S. Patent No. 8,424,972 (“the ‘972 Patent”).

WHEREAS, the PTAB determined that Caterpillar proved that claims 1, 15, 16, 22, and 26 are unpatentable, and that Caterpillar did not prove that claims 12 or 23 of the ‘972 Patent are unpatentable.

WHEREAS, Wirtgen America, Inc. (“Wirtgen”) is currently asserting claims 12 and 13 of the ‘972 Patent in this litigation.

WHEREAS, Wirtgen, in connection with the asserted ‘530 and ‘309 patents, previously moved for summary judgment that Caterpillar is estopped from raising invalidity grounds based on references that could have been reasonably raised in its IPRs on those patents. D.I. 217.

WHEREAS, this Court concluded that “[w]hen a party relies on a printed publication before the PTAB and then relies on a physical device in court, it relies on the same ‘ground’ if the printed publication and the physical device provide the same information.” D.I. 272 at 23.

WHEREAS, this Court found that “Wirtgen has shown that the physical products on which Caterpillar seeks to rely are ‘entirely cumulative’ of the printed publications,” and accordingly granted Wirtgen’s motion for summary judgment that IPR estoppel applies. D.I. 272 at 25.

WHEREAS, with regards to claim 12 of the ‘972 Patent, Caterpillar’s position is that every limitation of that claim is disclosed in the Caterpillar PM-565 and PM-465 cold planar machines.

WHEREAS, without waiving its right to appeal, Caterpillar does not dispute that pursuant to the grounds set forth in the Court’s summary judgement decision, IPR estoppel applies against Caterpillar with regards to claim 12 of the ‘972 Patent.

IT IS HEREBY ORDERED THAT, for the reasons set forth in the Court’s prior summary judgement decision (D.I. 272), IPR estoppel applies with regard to claim 12 of the ‘972 Patent.

IT IS SO ORDERED, this 13th day of February, 2024.

/s/ Joshua D. Wolson

U.S.D.J.

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